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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/777,889	02/12/2004	Tsutomu Okada	17442	6811
23389	7590	01/13/2006	EXAMINER	
SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				VRETTAKOS, PETER J
		ART UNIT		PAPER NUMBER
		3739		

DATE MAILED: 01/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/777,889	OKADA, TSUTOMU
	Examiner	Art Unit
	Peter J. Vrettakos	3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 February 2004.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-8 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 12-12-04.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## DETAILED ACTION

The Applicant is requested to check the beginning of the Specification with the Bib Data Sheet to ensure that the two lists the same priority information.

Pending claims are 1-8.

IDS filed 12-12-04 has been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Kittur et al. (5,846,241).

Kittur discloses a high-frequency knife (10), comprising: an electrically insulating flexible sheath (32) having a distal end and a proximal end (both depicted in figure 1); an operation member (22) having a distal end and a proximal end, and movable in an axial direction (see arrows attached to numerals 2 and 3 in figure 1, implying movement) in the sheath; an electrode part provided on the distal end of the operation member, at least a part (24) of the electrode part being axially projected from and retracted in the distal end (30) of the sheath, the electrode part having a rod electrode (20) part extending in the axial direction of the sheath and a plate electrode (24) part

disposed on a distal end of the rod electrode part, the plate electrode part including a plane surface part extending in a direction crossing the axis direction of the sheath (depicted at distal end of 10 in figure 1), a handheld operation section (depicted adjacent the proximal port in figure 1) provided on the proximal end of the sheath, the operation section having a slider part which moves the operation member in the axial direction of the sheath (disclosure regarding moving of electrodes: col. 2:66 through col. 3:4; col. 3:35-38); and a connector part provided on the slider part, and having an internal end portion and an external end portion, the external end portion being electrically connected with a cord (16,20) communicating with a high-frequency generating source (18), and the internal end portion being electrically connected with the electrode part through the operation member.

2. A high-frequency knife according to claim 1, wherein the plate electrode part has a plurality of hook portions (50, figure 8, "lip" = hook) on its external periphery.

3. A high-frequency knife according to claim 2, wherein the plate electrode part has a disc (24, figure 3b), and the hook portions has a plurality of projections (50) provided on an external peripheral surface of the disc (implied by combining figure 3b, 24 and figure 8,50), the projections being arranged along a line in a peripheral direction (50 is peripheral of 24) on the external peripheral surface of the disc.

8. A high-frequency knife according to claim 1, wherein the sheath (32) has at its distal end a receiving part (14) for the plate electrode part (24).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kittur et al. (5,846,241) in view of Sharkey et al. (6,379,350).

*Kittur is silent regarding alternate design plate electrodes.*

Sharkey discloses an analogous (to Sharkey) apparatus with alternate design plate electrodes (see figures 12-20). The motivation for the different designs is to provide the device with different functionalities each disclosed in the Sharkey patent.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify Kittur in view of Sharkey by including as design expedients, alternate design plate electrodes. The motivation would be to increase the number of applications for which the Kittur device could be used. An example is in Sharkey col. 14:1-11 where simultaneous scraping and delivery of RF power is disclosed (due to the design of the plate electrode).

4. A high-frequency knife according to claim 2, wherein the plate electrode part has a polygonal plate. (Alternate design choice made obvious argued above).

5. A high-frequency knife according to claim 4, wherein the polygonal plate has a triangular shape, and the hook portions are corner portions of the triangular plate. (Alternate design choice made obvious argued above).

6. A high-frequency knife according to claim 5, wherein the corner portions has sharp edge. (Alternate design choice made obvious argued above).

7. A high-frequency knife according to claim 3, wherein the plate electrode part has a plurality of rod arms projected outward from a central portion of the plate electrode part, and the arms being connected to each other to form a polygonal shape. (Alternate design choice made obvious argued above).

### ***Double Patenting***

The **nonstatutory** double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed **terminal disclaimer** in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of **copending Application No. 10/823,814**. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a diathermic cutter – also note similarities in the figures.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of **copending Application No. 10/718,189**. Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose a diathermic cutter – also note similarities in the figures.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos  
January 5, 2006

*sp*

*Roy D. Gibson*  
ROY D. GIBSON  
PRIMARY EXAMINER